

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

SANDISK CORPORATION,

No C-01-4063 VRW

Plaintiff,

ORDER

v

MEMOREX PRODUCTS, INC, et al,

Defendants.

_____ /

Defendant Pretec Electronics Corporation ("Pretec") moves the court for summary judgment of non-infringement. Pretec Mot (Doc # 322). Defendant Memorex Products, Inc ("Memorex") moves to join Pretec's motion for summary judgment. Memorex Mot (Doc # 330). According to the analysis below, the court GRANTS in part and DENIES in part Pretec's motion for summary judgment. The court declines, at this time, to rule on Memorex's motion to join Pretec's motion for summary judgment.

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I

SanDisk owns United States Patent No 5,602,987 (the "'987 patent"). See Order (Doc # 318) at 4-6. Claims 1 and 10 of the '987 patent cover a method for using electronically erasable programmable read only memory ("EEPROM"). EEPROM memory is often used in devices such as digital cameras.

In the court's September 30, 2003, order, the court limited its claim construction to two terms in claims 1 and 10 because further claim construction was unnecessary in considering the concurrently filed motion by defendant Ritek Corporation ("Ritek") for summary judgment of non-infringement. Id at 11-12. The court construed claims 1 and 10 to require the following: "Each non-volatile memory sector contained within an array of non-volatile floating gate memory cells must include at least one user data portion and one overhead portion." Id at 16. Because the court concluded that not all of the memory sectors in Ritek's products were partitioned into at least one user data portion and one overhead portion, the court granted Ritek's motion for summary judgment of non-infringement. Id at 33-37.

Defendants Pretec and Memorex moved to join Ritek's motion for summary judgment. Doc # 236. The court denied Pretec and Memorex's motion because Pretec and Memorex did not provide the court with a factual basis to conclude that their products contained at least one memory sector partitioned into only an overhead portion. Order (Doc # 318) at 3-4. Indeed, Pretec and Memorex provided no evidence at all. The court held that "[i]f Memorex and Pretec seek to move for summary judgment,

1 they must do so by filing a duly noticed motion accompanied by
2 affidavits that describe their individual products." Id at 4.

3 At a December 2, 2004, case management conference, the
4 court considered whether to enter judgment in favor of Ritek to
5 allow SanDisk to file an interlocutory appeal. Minute Order
6 (Doc # 321). Pretec and Memorex disagreed with this course of
7 action because they wished to file motions for summary judgment
8 before the case was appealed. The court declined to enter
9 judgment at that time and required Pretec and Memorex to bring
10 any dispositive motions no later than January 29, 2004. Id.
11 Pretec filed the present motion for summary judgment of
12 non-infringement in a timely manner. Pretec Mot (Doc # 322).
13 Memorex filed its motion to join Pretec's motion soon
14 thereafter. Memorex Mot (Doc # 330).

15 II

16 A

17 Pretec moves the court for summary judgment of
18 non-infringement on two grounds. First, Pretec presents facts
19 demonstrating that their products include, within the memory
20 array, non-volatile memory sectors that contain only overhead
21 portions. Tseng Decl (Doc # 323) at ¶ 4. In the September 30,
22 2003, order, the court construed claims 1 and 10 to mean that
23 "[e]ach non-volatile memory sector contained within an array of
24 non-volatile floating gate memory cells must include at least
25 one user data portion and one overhead portion." Order (Doc
26 # 318) at 16. Accordingly, Pretec's products do not practice
27 the claimed invention.
28

SanDisk does not substantively oppose this ground of Pretec's motion. Instead, SanDisk insinuates that Pretec's motion on this ground is improper because it does not raise a "new non-infringement argument[]." Pl Opp (Doc # 336) at 3-4. The court is unpersuaded by SanDisk's protestation. At the December 2, 2003, case management conference, SanDisk requested that the court stay the claims against Pretec and Memorex while SanDisk appealed the court's order granting summary judgment in favor of Ritek. SanDisk represented that if the court's order were affirmed, SanDisk would agree to enter judgment in favor of Pretec and Memorex. Ladra Decl (Doc # 337) at ¶ 2. But such a course of action was understandably unappealing to Pretec and Memorex. Allowing immediate appeal in favor of Ritek alone would have barred Pretec and Memorex from participating in the appeal. The court thus rejected SanDisk's argument at the December 2, 2003, case management conference and again rejects it here.

Accordingly, the court GRANTS summary judgment of non-infringement in favor of Pretec on the above-mentioned ground.

B

Memorex moves to join Pretec's motion for summary judgment. Memorex Mot (Doc # 330). Memorex argues that a decision granting summary judgment of non-infringement in favor of Pretec also requires the court to grant summary judgment in favor of Memorex because "the accused flash memory cards, which Memorex is alleged in the Complaint to have marketed and sold,

1 are Pretec flash memory cards that Memorex purchased from Pretec
2 and C-One Corporation." Memorex Mot (Doc # 330) at 1. The
3 court would agree with Memorex that summary judgment in
4 Memorex's favor is warranted if the quoted statement in the
5 prior sentence were made in a declaration or other form of
6 admissible evidence. See FRCP 56(e). But the court finds
7 Memorex's motion to join in a motion for summary judgment must
8 again be denied because the factual basis of Memorex's request
9 is insufficient.

10 Memorex provides the declaration of Michael Golacinski,
11 who declares:

12 Memorex purchased all of the products accused of
13 infringement by SanDisk in the Complaint from C-One
Corporation and Pretec Electronics.

14 Golacinski Decl (Doc # 332) at ¶ 6. The declaration reiterates
15 the claim that Memorex purchased flash memory cards from C-One
16 Corporation and Pretec. The declaration omits, however, the
17 crucial fact stated in Memorex's moving papers, namely that the
18 products purchased from C-One Corporation and Pretec Electronics
19 "are Pretec flash memory cards." Memorex Mot (Doc # 330) at 1
20 (emphasis added). Presumably, Memorex purchased Pretec flash
21 memory cards from Pretec, but the court is not willing to infer
22 the same for the unknown entity, C-One Corporation. Instead,
23 Memorex must provide evidence, not merely a statement by an
24 attorney, that the Memorex products accused of infringement are
25 Pretec flash memory cards or are otherwise non-infringing flash
26 memory cards. Because Memorex's failure appears to be a mere
27 error in drafting the Golacinski declaration, Memorex is given
28 leave to file a supplemental declaration no later than April 30,

1 2004, to accompany its present motion to join Pretec's motion
2 for summary judgment. Accordingly, the court declines, at this
3 time, to rule on Memorex's current motion to join Pretec's
4 motion for summary judgment (Doc # 330).

6 III

7 Pretec also moves the court to grant summary judgment
8 of non-infringement based on a construction of the word
9 "corresponds" in claims 1 and 10 of the patent. Pretec Mot (Doc
10 # 322) at 5-12.

11 SanDisk argues that Pretec's current motion is improper
12 because claim construction in the above-captioned case is
13 closed. SanDisk Opp (Doc # 336) at 4-5; see FRCP 16; Patent
14 LR 4. SanDisk and Ritek submitted a joint claim construction
15 statement on August 2, 2002 (Doc # 116), and claim construction
16 briefing in September 2002 (Doc ## 136, 148). Due to serious
17 problems involving counsel for Pretec and Memorex, the court
18 allowed substitution of counsel and an extension of time within
19 which to file further claim construction briefing. See Doc
20 # 225 at 2-6; Doc # 240. After retaining new counsel, Pretec
21 and Memorex filed a notice of joinder (Doc # 242) in the joint
22 claim construction statement filed by SanDisk and Ritek. Pretec
23 and Memorex raised no new issues in the notice of joinder. As
24 mentioned above, on September 30, 2003, the court issued its
25 combined claim construction and summary judgment order, limiting
26 its claim construction to only two terms. Order (Doc # 318).

27 Pretec contends that its present motion does not
28 require further claim construction because the motion is based

1 merely on the dictionary definition of the term "corresponds."
2 Pretec Reply (Doc # 343) at 2-3. For this proposition, Pretec
3 cites Texas Digital Systems, Inc v Telegenix, Inc, 308 F3d 1193,
4 1202-04 (Fed Cir 2002). Pretec Reply (Doc # 343) at 3 n6. Even
5 though the Texas Digital Systems court discusses the ability to
6 use dictionaries "at any stage of the litigation," the court
7 does so under a heading titled "The Contours of Claim
8 Construction" and in a discussion of the district court's
9 Markman order. 308 F3d at 1202. The court finds, therefore,
10 that Texas Digital Systems provides no support for Pretec's
11 contention that the application of a dictionary definition does
12 not constitute claim construction. Further, the construction of
13 the term "corresponds" is not as straightforward as Pretec
14 claims and the construction of the term "corresponds" is not
15 undisputed.

16 The court agrees with SanDisk that Pretec is advancing
17 a new claim construction argument after the close of claim
18 construction briefing. Because the court narrowly limited its
19 claim construction in the September 30, 2003, order, additional
20 claim construction by the court is not necessarily barred. If
21 Pretec were asking the court to consider claim construction
22 arguments raised in the joint claim construction statement,
23 Pretec's motion would not necessarily be improper. But Pretec's
24 proposed construction of the word "corresponds" was not raised
25 in the joint claim construction statement. Because Pretec had
26 an opportunity to raise new issues but chose, instead, to rely
27 solely on the issues raised by SanDisk and Ritek in the joint
28 claim construction statement, the court finds it appropriate to

1 bar Pretec from raising a new claim construction argument at
2 this stage of the litigation.

3 Further, the court finds that such additional claim
4 construction is improper because Ritek is no longer
5 participating substantively in the litigation at the district
6 court level. Pursuant to the court's direction, Ritek did not
7 attend the December 2, 2003, case management conference. See
8 Order (Doc # 318) at 38. It is unclear to the court whether
9 Ritek would seek to join Pretec's present motion. Even so,
10 Ritek would be prejudiced by not being given the opportunity to
11 present its views on Pretec's proposed construction of the term
12 "corresponds."

13 Accordingly, the court DENIES Pretec's second ground
14 for summary judgment (Doc # 322).

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16 IV

17 SanDisk moves the court to strike the declaration of
18 Pretec's expert Vivek Subramanian. SanDisk Mot (Doc # 339).
19 SanDisk claims that the other parties in the above-captioned
20 case were not given notice that Subramanian would be accessing
21 confidential information as required by the protective order in
22 this case. Id. Pretec's counsel admits that he inadvertently
23 failed to send to all parties for their approval an agreement to
24 be bound by the protective order that was signed by Subramanian
25 on November 25, 2002. Letter, Ron Finley, February 13, 2004
26 (Doc # 347, Exh A).

27 The court DENIES SanDisk's motion to strike
28 Subramanian's declaration because the motion is irrelevant.

1 Subramanian's declaration is material only to Pretec's second
2 ground for summary judgment based on the construction of the
3 term "corresponds." Because the court denies Pretec's second
4 ground for procedural reasons, the court need not consider
5 Subramanian's declaration.

6 SanDisk also seeks sanctions. SanDisk moves the court
7 "to order Mr. Subramanian to return any and all 'Confidential'
8 or 'Highly Confidential - Attorneys' Eyes Only' materials
9 designated by SanDisk." SanDisk Mot (Doc # 339) at 4. Pretec
10 opposes this sanction first because the confidential information
11 that SanDisk claims was disclosed improperly to Subramanian is
12 Ritek's proprietary information and that Pretec has obtained
13 Ritek's permission to allow Subramanian to access its
14 proprietary information for purposes of this litigation. See
15 Letter, Charles Sanders, Feb 19, 2004 (Doc # 347, Exh B).
16 Subramanian also claims that he did not review any attachments
17 marked confidential or highly confidential, although he did
18 review the March 21, 2003, declaration of Marcian Hoff.
19 Subramanian Decl (Doc # 346) at ¶ 3. Accordingly, the court is
20 unpersuaded that the sanctions SanDisk seeks are appropriate
21 and, therefore, DENIES SanDisk's motion for sanctions.

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23 V

24 In sum, the court GRANTS in part and DENIES in part
25 Pretec's motion for summary judgment (Doc # 322). The court
26 declines, at the present time, to rule on Memorex's motion to
27 join (Doc # 330) Pretec's motion for summary judgment. Memorex
28 may file a supplemental declaration no later than April 30,

1 2004. The court DENIES SanDisk's motion to strike and for
2 sanctions (Doc # 339).

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4 IT IS SO ORDERED.

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6 Date: 4/20/2004

7 /s/
8 VAUGHN R WALKER
9 United States District Judge
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